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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,132	11/21/2003	Jennifer Lynne Tomich		1131
26918	7590	05/20/2005		
WHITE & FUDALA 57 BEDFORD STREET SUITE 103 LEXINGTON, MA 02420			EXAMINER BLAKE, CAROLYN T	
			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/707,132

Applicant(s)

TOMICH, JENNIFER LYNNE

Examiner

Carolyn T Blake

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,15 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 14 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species I in the reply filed on March 28, 2005 is acknowledged. The traversal is on the ground(s) that claim 1 is a generic claim. This is not found persuasive. According to MPEP 806.04(d), a generic claim "must comprehend within its confines the organization covered in each of the species." In this case, claim 1 is not generic because it does not include the additional structure of a lever handle (claims 2 and 3). Moreover, for a proper traversal, Applicant is required to submit evidence or admit on the record that the species are obvious variants of each other. Applicant has not done this.

2. The requirement is still deemed proper and is therefore made FINAL.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "101" has been used to designate both a punch rod and a lower sharpened end of the rod.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

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any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The disclosure is objected to because of the following:

- Page 6: A brief description of FIGS 7 and 7b should be added.
- Paragraph 37, pages 7 and 8: It is not obvious to the Examiner that the lower assembly would remain aligned with the upper assembly when the upper assembly is moved. For example, when one moves one magnet, the other drags due to characteristics such as air friction, surface friction, magnetic strength, and inertia.
- Paragraph 49, page 11, line 7: "recessrecess" should be deleted.
- Page 13, lines 1 and 4: "magnet"s" should be changed to -magnet's- -.
- It is noted the specification contains numerous instances of improper comma use. Applicant is encouraged to carefully proofread the disclosure.

Appropriate corrections are required.

Claim Objections

6. Claim 1 is objected to because of the following informalities: "the surface" (line 13) lacks proper antecedent. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (4,594,927) in view of Abe (4,058,335).

Regarding claim 1, Mori discloses a punching device for punching paper (40) comprising: (a) an upper frame (30); (b) a cooperating upper magnetic base (38); (c) one or more punch rods (7) slideably disposed within the upper frame, each passing through a corresponding clearance hole (41) formed in the upper magnetic base; and (d) a lower magnetic base (39) further comprising a punch die corresponding to each punch rod which magnetically aligns with the upper magnetic base when said sheet material is disposed between the upper and lower magnetic base, so that the punch may be used to perforate said sheet material anywhere on a surface of the sheet. Mori fails to disclose the magnetic base supports the frame. However, Abe discloses a magnetic base (1a) that supports a frame (3). See FIG 7(b). Because the magnetic base projects beyond the frame, there is a more secure attraction between the magnets. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the magnetic base support the frame, as disclosed by Abe, on the Mori device for the purpose of creating a secure magnetic attraction.

Regarding claim 2, Mori discloses a lever handle (2) rotatably affixed to the upper frame (30), and which slideably engaged a top of each punch rod (7), providing a user with mechanical advantage in operating the punching device.

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Regarding claim 14, Mori discloses one punch rod (7), one clearance hole (41), and one punch die. By disclosing six rods and holes, Mori is also disclosing one due to the open claim language.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Evans et al (5,730,038), Jamieson (2,145,725), Pobanz (1,540,860), and Robinson, Jr. (3,683,399) disclose punching devices. Mitsuhashi (4,491,2610), Herrington et al (4,791,843) and Mori et al (6,663,331) disclose punching devices with magnets. Coker et al (4,428,098) and Yarborough (3,097,406) disclose magnetic bases.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn T Blake whose telephone number is (571) 272-4503. The examiner can normally be reached on Monday to Friday, 8:00 AM to 5:30 PM, alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 13, 2005



Allan N. Shoap
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